

REMARKS

Claims 1-28 are pending in the present application. In the Office Action, claims 1-28 stand rejected.

Applicant respectfully requests that the Examiner send future correspondence in view of the Power of Attorney by Assignee of Entire Interest, Revocation of Prior Powers and Change of Correspondence Address filed on September 9, 2004.

Applicant respectfully requests that the attorney docket number be changed from "WIDC-019/00US" to --15979US01--.

Claims 14 and 15 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. First, the Office Action states that it is unclear whether the elements following the phrase "a type" are part of the claimed inventions. Applicant respectfully submits that if elements are recited in the claims, then they are elements of the particular claimed inventions. Second, the phrase "detecting a type of the device" is not indefinite. Applicant respectfully submits that detecting a device type is not ambiguous. It is therefore respectfully requested that the rejection under 35 U.S.C. § 112, ¶ 2, be withdrawn with respect to claims 14 and 15.

Claims 23-27 were objected to for a noted informality, namely, the misnumbering of claims. In particular, claim number 23 was used twice. Applicant has amended claims 23-27, thereby renumbering claims 23-28. It is therefore respectfully requested that the objection be withdrawn.

Claims 1-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,255,800 B1 ("Bork").

To maintain an anticipation rejection based on Bork, each and every element recited in the claims must be described in Bork. Applicant has amended claims 1, 11, 16 and 24. Claims 1 and 24 recite "wherein the electronic system does not have to be aware of the first protocol to be in communication with the device". Claim 11 recites "the electronic system not having to be aware of the first protocol to be in communications with the device". Claim 16 recites "wherein the personal computer does not have to be aware of the first protocol to be in communication with the device". At least the above-recited elements are not described in Bork.

In fact, Bork teaches away from the claimed elements. For example, FIGS. 18 and 19 of Bork clearly show that the personal computer 10 or the portable computer 70 are aware of the

Bluetooth protocol. FIG. 18 shows, for example, a Bluetooth Adviser 68. Col. 7, lines 4-16 of Bork state that

[t]he Bluetooth applications do not run on the phone. For example, on computer 10, you can implement an application called "Bluetooth Advisor" or something similar. At the control panel, you might have an icon "Bluetooth Advisor" which, when selected, utilizes a data sync profile to work with a service discover profile, which would list all the devices around computer 10 that are Bluetoothli (sic) devices. . . . The software below the host controller interface is run on the radio in cradle 46. The rest is run on computer 10's processor.

FIG. 19 also shows that the Bluetooth HC 64 is necessarily in communications with PC HCI Library of portable computer 70. In addition, FIG. 18 of Bork appears to show that the personal computer 10 includes a Bluetooth baseband processing stack coupled to its system bus.

For at least the above reasons, Applicant respectfully requests that the anticipation rejection based on Bork be withdrawn with respect to claims 1, 11, 16 and 24 and their respective dependent claims (i.e., claims 2-10, claims 12-15, claims 17-23 and claims 25-28).

Applicant respectfully challenges the assertion that the elements in claims 6-9, 14, 15, 21-23 and 28 are all inherent. Applicant believes that the Examiner is improperly applying the doctrine of inherency.

The well-known patent law treatise by Donald S. Chisum states that

Federal Circuit decisions emphasize that an anticipatory inherent feature or result must be consistent, necessary, and inevitable, not merely possible.

Chisum on Patents § 3.03[2][b] (December 2004). The United States Court of Appeals for the Federal Circuit ("the Federal Circuit), which is binding on the United States Patent and Trademark Office, has held that

anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation

Transclean Corp. V. Bridgewood Services, Inc, 290 F.3d 1364, 1373, 62 U.S.P.Q. 2d 1865 (Fed. Cir. 2002). The Federal Circuit has also held that

[i]nherency does not embrace probabilities or possibilities

and that

[i]nherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art.

Trintec Indus., Inc. V. Top-U.S.A. Corp, 295 F.3d 1292, 1297, 63 U.S.P.Q. 2d 1597 (Fed. Cir. 2002).

Applicant respectfully submits that the elements recited in the claims may be probable or possible elements, but are not necessary elements. In other words, if components and relationships other than the elements recited in the claims could be used, then the doctrine of inherency does not apply. For at least the above reasons, it is respectfully requested that the rejections based on the inherency doctrine be withdrawn.

If the Examiner, in a subsequent office action, takes Official Notice or merely alleges that such elements are well-known in the art without any documentary support, then Applicant respectfully draws the attention of the Examiner to M.P.E.P. § 2144.03(E) which clearly states that

[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Accordingly, in such a case, Applicant respectfully submits that the Examiner either must produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

In view of at least the foregoing, it is respectfully submitted that the pending claims 1-28 are in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

Please charge any required fees not paid herewith or credit any overpayment to the
Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Dated: February 22, 2005

Respectfully submitted,



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